

## **REMARKS**

The drawings were objected to as failing to comply with 37 C.F.R. 1.84 (p)(5) as not including a figure mentioned in the description and for including reference character 50 in FIG. 6 that was not mentioned in the description. The inadvertent reference to Figure 3D has been corrected by way of an amendment to the specification such that the cited portion of the specification now references Figures 3B and 3C, which are in the published figures in the application. Mention of reference character 50 has also been added by way of amendment to the description. No new matter has been added by the amendments to the description. Accordingly, Applicants believe that the drawings are now in compliance with 37 C.F.R. 1.84 (p)(5).

The Non-Final Office Action, mailed October 31, 2007, considered claims 1-16. Claims 1, 8, and 13 were rejected under 35 U.S.C. §112 as being indefinite for failing to point out and distinctly claim subject matter. Claims 1 and 8 have been amended to remove the terms "substantially" and "generally." Claim 8 has been further amended to replace the term "lateral" with the term "radial" in response to a request for clarification. Claim 13 has been amended to change the term "compression" to "compressing," which has antecedent support in claim 8 that specifically recites a step for "compressing said precursor in a radially inward direction to bring said tines closer together." No new matter was added by any of the amendments to the claims. Accordingly, it is believed that claims 1, 8, and 13 are now in compliance with 35 U.S.C. §112. Claims 1-16 are pending.

Claims 1-10 and 12-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miura (US Patent 5,092,941), hereinafter Miura, in view of Peterson et al. (US Patent 6,152,937) hereinafter Peterson. Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Miura, in view of Peterson as applied to claims 8 and 9, and further in view of Kleshinski et al (US Patent 5,540,712).

Claim 1 recites a step that includes "forming the precursor . . . having an annular body which is planar and having one or more tines which extend radially outwardly from said body." Claim 1 recites a further step that includes "inverting said precursor such that said tines extend radially inwardly." The Office Action admits, "Miura fails to teach an annular, planar clip comprising one or more tines, and further fails to teach an inverting step in which the tines initially extend radially outwardly and subsequently inward after inversion." Office Action, p. 6.

The Office Action asserts that Peterson remedies this deficiency despite admitting, "Although Peterson does not express an inverting step, it would have been obvious to one of ordinary skill in the art to implement such a bending motion in order to obtain a desired final shape." *Id.* Applicants respectfully disagree.

Peterson teaches a method of manufacturing a component that begins with forming a sheet into a cylindrical tube. *See* Peterson, col. 5, ll. 48-49. Peterson further teaches, "The next step involves cutting or machining the tube." *Id.* at col. 5, l. 50. Steps for cutting are such that "[t]he starting tube is machined into the configuration (represented as a plane in FIG. 2) by laser cutting, electron discharge machining (EDM), or etching." *Id.* at col. 6, ll. 27-29. These features include fingers labeled as 18 and 20. *See id.* FIG. 2. Further, Peterson makes clear that initially as fingers 18 and 20 are formed, they are aligned axially relative to the rest of the cylindrical tube. *See id.* at col. 5, l. 56 through col. 6, l. 26 and FIG. 2. Peterson continues, "The next step is to deflect the fingers on the machined tube to approximately the positions that are desired in the **finished and installed** connector." *Id.* at col. 6, ll. 35-37. As illustrated in FIG. 2, the final position of the fingers is such that the fingers extend **outwardly**, not **inwardly**, from the machined tube. *See id.*, FIG. 3.

Accordingly, the portion of Peterson cited by the Office Action teaches bending the fingers close to the final position. In particular, Peterson teaches moving the fingers from an axial alignment into a position in which the fingers point **radially outward**. Accordingly, Peterson does not disclose, teach, or suggest a method that includes inverting the precursor such that the tines extend **radially inwardly** after having initially formed a precursor in which the tines extend radially outwardly from the body as recited in claim 1.

Later, Peterson does note, "It will be appreciated that it may be desirable to deflect fingers 18 and 20 beyond their desired positions so that when they are substantially released during deployment, they will resiliently bear on the tissue in which the connector is installed in the effort to return to the positions to which they have been deflected in this step of their manufacture." Peterson, col. 6, ll. 39-47. While disclosing deflection of the fingers away from the final position, this additional movement acts to further deflect the fingers radially **outwardly**. Such additional movement does not disclose, teach, or suggest a method that includes inverting the precursor such that tines extend radially inwardly.

Furthermore, the Office Action admits that "Miura fails to teach an annular, planar clip comprising one or more tines." Office Action, page 6. However, the Office Action asserts that "Peterson teaches a medical graft connector ... [that] is annular, planer and possesses a plurality of tines." *Id.* Applicants respectfully submit that Peterson does not disclose a planar clip, as recited in claim 1. In addition, the Office Action has not cited, nor can Applicants find, any portion of Peterson that discloses, teaches, or suggests this limitation. Rather, Peterson discloses a "sheet [formed] into a cylindrical tube." Peterson, col. 5, ll. 48-50 *see also* Figs. 1 and 3. Applicants submit that a **cylindrical** tube is not "**planar**," as recited in claim 1.

As a result, the combination of Miura and Peterson fails to disclose, teach, or suggest each and every element of claim 1. Applicants thus request the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Miura in view of Peterson be reconsidered and withdrawn. Dependent claims 2-7 and 13-15 include all of the elements of claim 1. Therefore, Applicants respectfully request the rejection of claims 2-7 and 13-15 also be reconsidered and withdrawn.

Independent claim 8 is also rejected under 35 U.S.C. §103(a) as being unpatentable over Miura, in view of Peterson. The method of claim 8 includes a step that includes "forming the precursor of a clip . . . having a generally annular body which is generally planar and having one or more tines which extend inwardly from said body." As previously discussed, neither Miura nor Peterson, taken alone or in combination, teach the forming of a precursor in which the tines are bent to extend radially inwardly from the body. Rather, Peterson discloses moving the fingers from an axial alignment into a position in which the fingers extend **outwardly**, not "**inwardly**," as recited in claim 8.

Furthermore, as shown above, Peterson does not disclose, teach, or suggest a planar clip, as recited in claim 8. In addition, the Office Action has not cited, nor can Applicants find, any portion of Peterson that discloses, teaches, or suggests this limitation. Rather, Peterson discloses a "sheet [formed] into a cylindrical tube." Peterson, col. 5, ll. 48-50 *see also* Figs. 1 and 3. Applicants submit that a **cylindrical** tube is not "**planar**," as recited in claim 8.

As a result, neither Miura nor Peterson, taken alone or in combination, disclose, teach, or suggest each of the elements of claim 8. Applicants therefore respectfully request that the rejection of claim 8 under 35 U.S.C. §103(a) as being unpatentable over Miura, in view of Peterson be reconsidered and withdrawn. Claims 9-10, 12, and 16 contain all of the elements of

claim 8. Therefore, Applicants respectfully request that the rejection of claims 9-10, 12-13, and 16 also be reconsidered and withdrawn.

Claim 11 is rejected under 35 U.S.C. § 103 as being unpatentable over Miura in view of Peterson and in further view of Klenshinski et al (U.S. Pat. 5,540,712). Klenshinski teaches a medical stent made of nickel-titanium alloy and thus does not remedy the deficiencies of Miura and Peterson described above. Therefore, Applicants respectfully request that the rejection of claim 11 under 35 U.S.C. § 103 as being unpatentable over Miura in view of Peterson and in further view of Klenshinski be reconsidered and withdrawn.

In view of the above amendment and remarks, Applicants believe the application to be in condition for allowance and notice to that effect is respectfully requested. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 19<sup>th</sup> day of February, 2008.

Respectfully submitted,

/Fraser D. Roy, Reg.# 45666/

FRASER D. ROY  
Attorney for Applicant  
Registration No. 45,666  
Customer No. 057360

FDR:PNT:KF:kdj  
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